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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,504	01/25/2002	John H. Westerbeke JR.	00637-031001	4878
26161	7590	05/26/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ELKASSABGI, HEBA	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/057,504	WESTERBEKE, JOHN H.
Examiner	Art Unit	
Heba Elkassabgi	2834	

-- The MAILING DATE of this communication appars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 March 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) 1-23 and 27 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 24-26 and 28-34 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 May 2002 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION***Sp cification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-26 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grinde (US 4836123) and further in view of (Rustecki 4007387).

Grinde discloses in fig. 1-11 a power generator having in a marine motor with a four- stroke water-cooled engine (52) with a vertically - oriented drive shaft (64) and an alternator (54) with a vertically oriented rotor coupled for rotation with the engine drive shaft to produce electricity and laterally spaced from the engine shaft; and transporter frame 17 (admits air only for combustion) coupled to the engine and alternator mounted in side-by side with an outlet power. Wherein, the generator is mounted inside a boat hull (58), with an exhaust system of the engine including an exhaust (38) riser extending above a water line. Grinde also

disclose a platform (14) for securing the generator and a seawater pump (56) coupled to the shaft at an opposite end of the engine that a pulley (92) driving the alternator. Wherein, the engine is cooled by a circulated coolant (seawater) cooled in a liquid heat exchanger (26) and injected into the exhaust system. Grinde substantially discloses the claim features in figs. 1 -11. However, Grinde does not disclose the rotor having permanent magnets attached to an inner circumferential surface of the rotor. Wherein, the weight and position of the magnets are selected to balance firing impulse and radial acceleration of the engine and it's rotating components and a stationary stator responsive to the moving magnetic fields generated by the rotor and package with in the engine drive.

Rustecki teaches in fig.1-2 a generator having a rotor (fig.1) with permanent magnets (27) attached to an inner circumferential surface of the rotor. Wherein, the weight and position of the magnets are selected to balance firing impulse and radial acceleration of the engine and it's rotating components and a stationary stator fig.6-(50)-responsive-to-the-moving-magnetic-fields-generated-by the rotor and package with in the engine drive for the purpose of producing high output at low speed when functioning as an alternator. The method is inherent based on the structural limitations of the claims.

Therefore it would have been obvious to one having ordinary skill in art at the time the invention was made to modify the generator of Grinde with the teaching of Rustecki for the purpose to of producing a high output.

Additionally, it would have been an obvious matter of design choice to design to reduce the size of the generator to less than 20 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955)

Response to Arguments

Applicant's arguments filed 03/18/2004 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation of "A marine electrical power generator mounted inside a boat hull," has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985).

In that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying

the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Grinde and Rustecki teach the structural limitations as disclosed above. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heba Elkassabgi whose telephone number is (571) 272-2023. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on (571) 272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Heba Elkassabgi


Nicholas Ponomarenko
Primary Examiner
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5/19/04